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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,460	11/05/2003	Yasuhito Soma	HYAE:095B	6368

6160 7590 06/24/2005  
PARKHURST & WENDEL, L.L.P.  
1421 PRINCE STREET  
SUITE 210  
ALEXANDRIA, VA 22314-2805

EXAMINER

HUBER, PAUL W

ART UNIT PAPER NUMBER

2653

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/700,460

Applicant(s)

SOMA ET AL.

Examiner

Paul Huber

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/492,269.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 110503.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, claim 9 recites: a "spot position detection means for generating a spot position signal"; a "correction signal generation means for receiving the spot position signal as an input, and generating a correction signal"; a "subtracting means for subtracting the correction signal from the spot position signal"; and a "control means for causing a traverse loop filter to filter an output of the subtracting means". These claimed elements can only be found within the specification with reference to the disclosed embodiment of the invention illustrated in figure 7. Claim 9 further recites "first control means for causing a spot position loop filter to filter the spot position signal to generate a first processed signal and outputting the first processed signal to the first moving means". However, there is no such "first control means" within the embodiment of the invention disclosed with reference to figure 7, e.g., there is no "spot position loop filter to filter the spot position signal" generated by spot position detection circuit 110 of figure 7. Accordingly, claim 9 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, claim 9 recites: a "spot position detection means for generating a spot position signal"; a "correction signal generation means for receiving the spot position signal as an input, and generating a correction signal"; a "subtracting means for subtracting the correction signal from the spot position signal"; and a "control means for causing a traverse loop filter to filter an output of the subtracting means". These claimed elements can only be found within the specification with reference to the disclosed embodiment of the invention illustrated in figure 7.

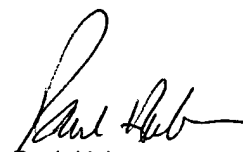
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Claim 9 further recites "first control means for causing a spot position loop filter to filter the spot position signal to generate a first processed signal and outputting the first processed signal to the first moving means". However, there is no such "first control means" within the embodiment of the invention disclosed with reference to figure 7, e.g., there is no "spot position loop filter to filter the spot position signal" generated by spot position detection circuit 110 of figure 7. Accordingly, claim 9 contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, claim 9 is rejected as being indefinite because it is not understood how the "first control means", which appears to correspond to an embodiment of the invention disclosed with reference to figure 4, forms a structural cooperative relationship with the "correction signal generation means", "subtracting means" and "control means" which appears to correspond to a different embodiment of the invention disclosed with reference to figure 7. Perhaps the applicant actually meant the "first control means for causing a tracking loop filter [spot position loop filter] to filter a tracking error signal [the spot position signal] to generate a first processed signal and outputting the first processed signal to the first moving means".

Any inquiry concerning this communication should be directed to Paul Huber at telephone number 571-272-7588.

  
Paul Huber  
Primary Examiner  
Art Unit 2653

pwh  
June 22, 2005